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S.N. 10/509,641
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REMARKS:

Claims 11-23 are currently pending. Claims 11- 23 are based on the original Claims but Applicants have added the stages involved in the method to bring the Claims into better form.

Claim Rejections under 35 USC §§ 102 and 103

Claims 2-4 and 6-10 are rejected for allegedly being anticipated by US 6,117,459 or in the alternative, obvious in light of said cited art. Applicants respectfully disagree.

Claims 2-4 and 6-10 are canceled and as such, said rejections are moot. Nonetheless, since new Claims 11-23 are based on the aforementioned canceled Claims, the Examiner's rejections will be addressed.

Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as it is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). It is not enough, however, that the reference discloses all the claimed elements in isolation. Rather, as stated by the Federal Circuit, the cited art reference must disclose each element of the claimed invention "arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

To establish *prima facie* obviousness, the examiner must show in the prior art some suggestion or motivation to make the claimed invention, a reasonable expectation for success in doing so, and a teaching or suggestion of each claim element (*see, e.g., In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

US 6,117,459 fails to disclose or suggest filtering and/or stabilizing an aqueous liquid comprising the step of passing a suspension consisting of a discontinuous phase and a continuous phase through a porous filter medium at a constant flow rate as recited in the instant Claims. Accordingly, the cited art fails to disclose each element of the instant Claims arranged as in the Claims and as such, fails to meet the standards required for §§ 102 and 103 rejections.

For at least the reasons listed above, Applicants respectfully request withdrawal of the

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instant rejections and favorable action is solicited.

Double Patenting

Applicants assert based on the new Claims contained herein and on the arguments listed above, that the instant invention is not obvious in light of copending Application No. 10/398,179 in view of US 6,117,459. Further, US 6,117,459 merely provides a listing of possible filtration adjuvants and offers only an invitation to explore, not a motivation to combine with the copending Application with an expectation of success (*See e.g., Ex parte Obukowicz*, 27 USPQ 2d 1063 (BPAI 1992)). The cited art discloses synthetic or non-synthetic polymers grains or incompressible natural grains or any number of other compositions. Consequently, the obviousness of the functional equivalency would be unknown to one of ordinary skill in the art. Moreover, Applicants respectfully assert that the Examiner appears to have picked and chosen elements from the cited art while failing to analyze the cited art reference as a whole. As the Federal Circuit has explained:

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc., v. Barnes-Hind/Hydrocurve, Inc.*, 796, F.2d 443, 448 (Fed. Cir. 1986) (quoting *In re Wesslau*, 355 F. 2d 238, 241 (CCPA 1965))

Accordingly, Applicants respectfully submit that the art cited fails to render the instant invention obvious and request withdrawal of the instant provisional Double Patenting rejections. Favorable action is solicited.